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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/529,738

03/30/2005

Yasuyuki Mizuno

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EXAMINER

SELLERS, ROBERT E

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

10/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/529,738	Applicant(s) MIZUNO ET AL.	
	Examiner ROBERT SELLERS	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-87 is/are pending in the application.
- 4a) Of the above claim(s) 1-9, 11-49, 51, 52 and 56-86 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10, 50, 53-55 and 87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 1-9, 11-16, 18-30, 32-43, 45-49, 56-59, 66-69, 76-79 and 81-86 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim.
2. Claims 17, 31, 44, 60-65, 70-75, 80 and 86 are withdrawn as directed to non-elected species of phenol-modified (claims 17 and 60-65) or epoxy/phenol-modified (claims 31 and 70-75) cyanate ester oligomer with a polyphenylene ether, or an epoxy/phenol-modified cyanate ester oligomer reacted in the presence of a polyphenylene ether (claims 44 and 80).
3. Claim 85 denoting the reaction of a cyanate ester with a monovalent phenol in the presence of a polyphenylene ether is materially different from the mere mixture of the components in claim 10 which was the elected species of composition according to the election filed November 13, 2007 on page 34 referring to species (G) of the restriction and election of species requirement mailed November 11, 2007 (page 5). The elections were made **without** traverse in the reply filed on November 13, 2007.

The text of section 103(a) of Title 35, U.S. Code not included in this action can be found in the non-Final rejection mailed December 10, 2007.

Claims 10, 50, 53-55 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizuno et al. Patent No. 7,157,506.

The rejection is maintained for the reasons of record set forth in the non-Final rejections. The arguments filed September 25, 2008 have been considered but are unpersuasive.

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4. The effective filing date for Mizuno et al. is the 37 CFR 1.371 publication date for PCT/JP01/02237 of March 21, 2001 which antedates the Japanese priority applications date of September 30, 2002.

5. The examples in Tables 1 (specification, page 48), 3 (page 59), 5 (page 70) and 7 (page 81) are not reflective of the closest prior art brominated bisphenol A epoxy resin ESB400T shown in Example 19 of Mizuno et al. (col. 40) since it most closely resembles the claimed biphenyl structure-containing epoxy resin. Although Example 16 in Table 5 contains ESB400T, its combination with YX-4000 tetramethylbiphenol diglycidyl ether is not representative of the prior art use of ESB400T alone.

6. The evidence is inconclusive in the absence of holding the types and amounts of the other components constant to isolate the effect of the type of epoxy resin on the tested properties. The showings are not commensurate in scope with the claims regarding a representative sampling of the claimed range of biphenyl structure-containing epoxy resin of from 10 to 250 parts by weight per 100 parts by weight of cyanate ester required in claim 50.

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

(571) 272-1093 (Fax No. (571)-273-8300)
Monday to Friday, 9:30 to 6:00

/Robert Sellers/
Primary Examiner
Division 1796

rs
10/6/2008